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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CARL M. HOFFMASTER, DAVID K. TRUAX, and
TIMOTHY P. BEATON

Appeal 2007-3084
Application 10/774,134
Technology Center 3600

Decided: April 18, 2008

Before LINDA E. HORNER, DAVID B. WALKER, and BIBHU R. MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 of the final rejection of claims 201-204, 206-207, 210-212, and 217-218. Claims 1-200 have been canceled and claims 205, 208-209, and 213-216 have been

objected to as being dependent from a rejected claim but containing allowable subject matter. The Appellants presented oral arguments on April 10, 2008. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to an expandable reaming tool comprising at least two reamer pads operatively coupled to a tool body and adapted to be displaced between a retracted position and an expanded position. At least one spiral blade is formed on at least one reamer pad, and a plurality of cutting elements are disposed on the at least one spiral blade. (Specification, [0009]). Claim 201 reproduced below is representative of the subject matter of appeal.

201. An expandable reaming tool, comprising:
at least two reamer pads operatively coupled to a tool body and configured to be displaced between a retracted position and an expanded position;
at least one blade formed on at least one of the at least two reamer pads;
a plurality of cutting elements disposed on the at least one blade,
wherein the plurality of cutting elements are arranged so as to substantially balance at least one parameter selected from axial force, lateral force, work, and mass between the at least two reamer pads;
wherein the expandable reaming tool is configured to ream while drilling.

THE REJECTION

The Examiner relies upon the following as evidence in support of the rejection:

Hailey (Hailey '374)	US 5,174,374	Dec. 29, 1992
Hailey (Hailey '793)	US 4,809,793	Mar. 7, 1989

Claims 201-204, 206-207, 210-212, and 217-218 are rejected under 35 U.S.C. § 102(b) as anticipated by Hailey '374.

THE ISSUE

The issue is whether the Appellants have shown that the Examiner erred in rejecting claims 201-204, 206-207, 210-212, and 217-218 as anticipated by Hailey '374 under 35 U.S.C. § 102(b).

This issue turns first on whether Hailey '374 discloses two reamer pads formed with a blade having a plurality of cutting elements.

This issue turns second on whether Hailey '374 discloses that the cutting elements are arranged to substantially balance at least one parameter selected from axial force, lateral force, work, or mass.

This issue turns third on whether claim 201 requires that the tool be "configured to ream while drilling" and if so whether the Hailey '374 reference discloses such a feature.

FINDINGS OF FACT

We find the following enumerated findings of fact are supported at least by a preponderance of the evidence¹:

1. Hailey '374 discloses a clean-out tool (Figs. 1-5) with blades (24a, 24b) each having an insert (30) with a polycrystalline diamond surface (55) arranged sequentially. (Figs. 1-5).
2. Hailey '374 describes the cutting blades as being "identical" (Col. 1:28-30).
3. Hailey '374 describes the diamonds as being "cutter elements" (Col. 2:63-65). (See also Col. 1:30-33).
4. Hailey '374 describes that its cutting blade can be used on a rotary clean-out tool, such as the tool described in U.S. Patent No. 4,809,783 (Hailey '793) (Col. 1:15-18).
5. The Hailey '793 Patent discloses a clean out tool with cutting elements (14) at the bottom of the shaft (Fig. 4) which will act as a drill.
6. Hailey '374 describes the tool being used in "opposition to drilling fluid" (Col. 2:3).

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

ANALYSIS

The Appellants initially argue (Br. 8-10) that the rejection of claim 201 is improper because the Hailey ‘374 reference does not disclose: a) “at least two reamer pads”, b) “at least one blade” formed on each of the pads, and c) “cutting elements” disposed on the blades (Br. 8). We disagree. Hailey ‘374 discloses two “blades” which correspond to the claimed “reamer pads” and two “inserts” which correspond to the claimed “blades” (FF 1). Hailey also discloses diamond cutters (FF 1) which correspond to the claimed “cutting elements.” The disclosed elements of the Hailey reference are arranged the same as the claimed limitations in claim 201.

The Appellants also argue (Br. 11-13) that the Hailey ‘374 reference does not show that the “cutting elements are arranged so as to substantially

balance at least one parameter selected from axial force, lateral force, work, and mass.”

We disagree. “[A] *prima facie* case of anticipation [may be] based on inherency.” *In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986). Once a *prima facie* case of anticipation has been established, the burden shifts to the Appellant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (“Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.”). *See also In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990). Here, the Hailey ‘374 reference describes the cutting blades as being identical (FF 2) which clearly would imply that the blades are “substantially balanced” at least in terms of mass, meeting the limitations in the claim. The Appellants have failed to meet the burden of demonstrating that the identical blades of Hailey are not at least “substantially balanced” with respect to mass.

The Appellants also argue (Br. 13-16) that the Hailey ‘374 reference fails to disclose that the tool can be used “while drilling” (Br. 14). We disagree. First, we note that limitation in claim 201 that the tool “is configured to ream while drilling” appears to be only a statement of intended use and not a positive recitation for a drill. Regardless, the Hailey ‘374 reference clearly states that the cut-out tool is meant to be used with the clean-out tool of the Hailey ‘793 patent, which clearly includes a drill (FF 4, 5). Further, the Hailey ‘374 reference states that the tool is operated in

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opposition to drilling fluid under pressure (FF 6) which further shows the tool can be used in drilling operations.

For the above reasons, we sustain the rejection of claim 201 under 35 U.S.C. § 102(b). As the Appellants have not separately argued for patentability of claims 202-204, 206-207, 210-212, and 217-218, we also sustain the rejection of these claims.

CONCLUSION

We conclude that Appellants have failed to show that the Examiner erred in rejecting claims 201-204, 206-207, 210-212, and 217-218 under 35 U.S.C. § 102(b) as anticipated by Hailey '374.

DECISON

The Examiner's rejection of claims 201-204, 206-207, 210-212, and 217-218 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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